



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/446,232	02/14/2000	PHILIP JOHN BIGGS	BW-398-2	2011

7590 07/16/2002

JOHN F SALAZAR
MIDDLETON & REUTLINGER
2500 BROWN & WILLIAMSON TOWER
LOUISVILLE, KY 40202

EXAMINER

LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
----------	--------------

1731

20

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-20

Office Action Summary	Application No.	Applicant(s)	
	09/446,232	BIGGS ET AL.	
	Examiner	Art Unit	
	Carlos Lopez	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-18,21-27 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-18,21-27 and 31-34 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Specification

Claims 4 and 5 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Dependent claims 4 and 5 do not include every limitation of its parent claim 3 because claims 4 and 5 depend on cancelled claim 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claims 1,4-15, and 31-34 are rejected under 35 U.S.C. 103(a) as being as being unpatentable over Gibson et al (US 3878850). Gibson discloses a smoking material having a non-polyol aerosol generator, up 20% by weight tobacco, binder and inorganic filler (Column 4, Ins. 34-46). As for claims 4-5, the non-polyol aerosol generator being glycerol triacetate, 5% by weight (Column 4, Ins. 34-46). As for claims 6-8, 14 and 33, the inorganic filler, calcium carbonate being present by 45% in weight (Column 4, Ins. 34-46). As for claims 9 and 10, there is no tobacco present in the smoking material, 0% (Column 4, Ins. 34-46). As for claims 11-13, 15 and 34, the binder, carboxymethyl cellulose, being present not more than 20% (Column 4, Ins. 34-46). The instant

specification as originally filed does not show a patentable distinction between 5 and 6% non-polyol aerosol generator. Additionally, glycerol triacetate is a compound shown by Gibson et al to provide desired effects in the smoke profile (Column 4, lines 51-62). Hence, it would have been obvious to a person of ordinary skill in the art to have increased the amount of glycerol triacetate from 5% to 6% in order to increase the benefits disclosed by Gibson et al.

As for claim 32, a polyol aerosol generator is present at 8.5% (Example 1).

2) Claims 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson et al (US 3878850). As disclosed above Gibson meets all the limitations of claim 1, from which claims 16 and 17 are dependent on. Gibson is silent on using an expansion medium or high oil containing materials. However, Gibson teaches that said smoking material may contain flavourants. It is well in known in the art that cocoa, having high fat content, is used as a flavourant. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included flavourants as taught by Gibson such as cocoa, as conventionally used, to enhance the smoking experience.

3) Claims 18 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson et al (US 3878850) in view of Schneider et al (US 5379789 and US 4986287). As disclosed above Gibson meets the limitations of claim 1. Gibson is silent in using said smoking material in a smoking article having a smoking rod and a filter, wherein the smoking rod comprises of a core and outer part. However, Schneider et al (US 5379789) discloses a filter and a smoking rod having a core and outer part, wherein

Art Unit: 1731

said core is a first smoking material (14) enwrapped by a cigarette paper wrapper (16) and wherein the outer part is a second smoking material (18) disposed annularly about said core with a second cigarette paper wrapper (20) enwrapping said second smoking material (18). As for claims 23 and 24, Schneider (US 5379789) discloses the outer part and core extending over the full length of the smoking rod and wherein said core is disposed coaxially of said rod (Figure). Schneider (US 5379789) teaches that said arrangement of the core and outer part results in a considerable reduction of secondary smoke (Column 2, Ins. 35-39). Additionally, Schneider et al (US 4986287) teaches that the core and outer part may be composed of different materials to achieve savings in cost production (Column 1, Ins. 20-25). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used Gibson's smoking material within a smoking article arrangement as disclosed by Schneider because it would reduce secondary smoke and reduce cost production.

4) Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibson et al (US 3878850) in view of Schneider et al (US 5379789 and US 4986287) and in further view of Brown et al (US 5056537). As disclosed above, in paragraph 4, the cited references disclose a smoking article having a smoking material, aerosol generator, binder, inorganic filler and filter. The cited references are silent on a filter having an aerosol generator, as defined in applicant's specification as a polyhydric alcohol in the last paragraph of page 3. However, Brown discloses a filter (20) having polyhydric alcohol to impart flexibility to the filter material and avoid heat application when the filter element is being shaped. It would have been obvious to a person of

ordinary skill in the art at the time the invention was made to have included an aerosol generator to the filter element of Schneider because it would impart flexibility to the filter.

Response to Arguments

Applicant's arguments filed 6/17/02 have been fully considered but they are not persuasive.

Applicant traverses the rejections made in paragraphs 1-4. Applicant argues that Gibson does not use glycerol triacetate as a non-polyol aerosol generator. Applicant's claim 1 recites a smoking material comprising a glycerol triacetate, its use as a non-polyol aerosol generator as claimed by applicant does not carry any patentable weight. Its use as an aerosol generator does not distinguish Gibson's smoking material from applicant's claims reciting non-polyol aerosol generator which applicant, in contradiction with its own arguments, defines it to be a glycerol triacetate.

In response to applicant's arguments against the references Brown ("537) and Schneider ("789), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The '789 patent provides a clear motivation to one of ordinary skill in the art to arrange the smoking material of the "850 patent in coaxial arrangement as taught by the '789 in order to reduce side stream smoke. Additionally, the '537 provides a clear

Art Unit: 1731

motivation to one of ordinary skill in the art to provide aerosol generators at the filter section in order to provide flexibility to a filter.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

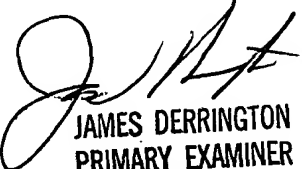
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

C.L
July 9, 2002


JAMES DERRINGTON
PRIMARY EXAMINER
ART UNIT ~~137~~-1731